

REMARKS

The present amendment is in response to the Official Action dated November 29, 2005. Claims 1, 2, 8, 9, 23, 27, 33, 34, 37, 41, 47, and 48 have been amended, but remain currently pending in the present application. Claims 13-22 have been withdrawn from prosecution. Therefore, claims 1-12 and 23-52 remain in the application and are currently pending. The following sets forth the Applicant's arguments relating to the presently pending claims.

In the Official Action, the Examiner first notes a restriction required under 35 U.S.C. § 121. Specifically, the Examiner sets forth that claims 1-12 and 23-52 are drawn to a variable angle cutting block, and claims 13-22 are drawn to a method of resecting bone, and requires that since the inventions are distinct, restriction for examination purposes is proper. In addition, the Examiner noted that during a telephone conversation of November 17, 2005 Applicant's counsel, Kevin Kocun, made a provisional election without traverse to the invention of claims 1-12 and 23-52. Applicant hereby affirms this election, and agrees that claims 13-22 should be withdrawn from further consideration in the present application. However, Applicant reserves the right to pursue such withdrawn claims in any divisional and/or continuation cases relating to the present application.

Further in the Official Action, the Examiner has rejected claims 1, 3, 11, 23, 28, 35, 37 and 51 under 35 U.S.C. § 101 because those claims recite elements which the Examiner has deemed to constitute non-statutory subject matter. More particularly, the Examiner has noted that those claims make reference to being "adjacent a bone" or "connected to said bone." In the Examiner's estimation, the human body and bones are non-statutory subject matter and thus cannot be claimed

within the structure of the invention. Although the Applicant disagrees with the Examiner's assertion that such references to a bone surface in the claims is improper, Applicant has amended at least independent claims 1, 23, and 37 in accordance with the Examiner's suggestions. Specifically, each of those claims has been amended to include the limitation that certain surfaces and/or elements of the adjustable bone resection guide be "adapted to be located adjacent" a bone surface, per the Examiner's own suggestions. Applicant trusts that such amendments to the independent claims make clear that the aim of the present invention is not to claim the Examiner's contended non-statutory subject matter. Although certain of the remaining dependent claims make reference to bone and/or bone surfaces, their dependency upon the amended independent claims makes it clear that such subject matter is not being claimed.

Still further in the Official Action, the Examiner has rejected claims 1-6, 8-12, 23-31, 33-45, and 47-52 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,608,898 to Volk ("Volk"), and claims 7, 32, and 46 under 35 U.S.C. § 103(a) as being obvious over Volk in view of U.S. Patent No. 6,796,986 to Duffner ("Duffner") and in further view of U.S. Patent No. 4,020,929 to Goldin ("Goldin"). Essentially, it is the Examiner's position that Volk teaches each of the limitations of claims 1-6, 8-12, 23-31, 33-45, and 47-52, while Duffner and Goldin obviate certain further limitations of claims 7, 32, and 46 which Volk does not teach. Specifically, with regard to Volk, the Examiner asserts that Volk discloses a first portion (29) able to be fixed with respect to a bone surface, a second portion (20) rotatably coupled to the first portion at a pivot point (30) with a guide having guide surfaces (22, 23) and a means for positioning the first and second portions relative to each other. In addition, the Examiner asserts that the means for positioning the first and second

portions relative to each other may be an arm (27) with a hole receiving a bolt or pin (36) and, being separate from the pivot point, the rotation of the first portion relative to the second portion maintains function if the first portion is attached to bone. The Examiner also makes further assertions regarding the teachings of Volk, as well as the teachings of Duffner and Goldin in light of certain additional limitations present in certain of the currently pending claims.

With regard to the aforementioned rejections of the currently pending claims in view of Volk, Duffner, and Goldin, Applicant respectfully disagrees with the Examiner's contentions. Even a cursory review of the Volk reference would indicate that the invention of that reference is not directed to the orthopedic and/or surgical fields. Rather, Volk teaches a saw guide and miter apparatus for use in cutting work pieces, such as wood or sheet metal pieces. In this regard, Applicant acknowledges the Examiner's opinion that the intended use, as set forth in the claims, carries no weight in the absence of any distinguishing structure. As such, Applicant has amended at least independent claims 1, 23, and 37 to more specifically claim the subject matter of the present invention.

Specifically, independent claims 1, 23, and 37, in addition to the aforementioned amendments relating to the recitation of bone and/or bone surface elements, have been further amended to include the limitation that the first portion have "a plurality of bone fastener receiving apertures." In addition, certain of those independent claims' respective dependent claims have also been amended to include bone fastener limitations. For example, dependent claim 2, which properly depends from independent claim 1, has been amended to recite that the bone resection guide include a bone fastener, while dependent claims 8 and 9, which also ultimately depend from independent claim 1, have similarly been amended to include the particular types of bone

fasteners which can be utilized, as well as to recite that the adjustable bone resection guide include a plurality of apertures and a plurality of bone fasteners located in the apertures. Applicant notes that similar, if not identical, amendments have been made to independent claims 23 and 37, and certain of their respective dependent claims. As such, Applicant respectfully submits that independent claims 1, 23, and 37 are not anticipated nor obviated by any of the prior art of record, especially the Volk reference. Volk does not teach fastener receiving apertures, and in fact given the intended use of the apparatus of Volk (i.e., cutting work pieces such as wood or sheet metal pieces) that reference teaches away from providing such apertures for fastening the device to an adjacent structure. Therefore, it is the Applicant's position that independent claims 1, 23, and 37 constitute allowable subject matter.

In addition, each of the aforementioned currently pending independent claims have also been amended to include the limitation that the bone resection guide claimed therein be "used in guiding a bone resecting tool." Clearly, Volk does not teach nor contemplate such a configuration. Rather, as has been mentioned above, the saw guide and miter apparatus of Volk is suitable for use in cutting wood or sheet metal pieces. There is simply no disclosure in the Volk reference relating to its possible use in cutting a bone, nor would those of ordinary skill in the art relating to the invention of Volk, recognize the utility of the invention of Volk in the orthopedic field. Therefore, the Applicant respectfully points out that independent claims 1, 23, and 37 further define over the prior art of record.

In light of all of the above, Applicant respectfully submits that currently pending independent claims 1, 23, and 37 are not anticipated nor suggested by any of the prior art of

record. As such, Applicant respectfully requests that the rejections of such claims be removed and the claims be moved into a condition of allowance. Similarly, given that the remaining claims of the application are dependent claims properly depending upon either independent claim 1, 23, or 37, or an intervening dependent claim, allowance of currently pending claims 1-12 and 23-52 is also respectfully requested.

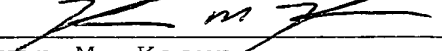
As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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